

UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,371 (RT)

RUEY J. YU
and EUGENE VAN SCOTT¹
(6,159,485),
Junior Party,

v.

NEOSE TECHNOLOGIES, INC.
and E-L MANAGEMENT
(09/123,251),
Senior Party.

JUDGMENT - Bd. R. 127(b) - REQUESTED

Before TORCZON, DELMENDO, and LANE, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

1 Contingent on the granting of its motion 1, Yu requests adverse judgment under Bd.R.
2 127(b). The contingency having been met in Paper 23, the request is GRANTED.

3 A clarification is in order regarding estoppel. Yu notes that it is not estopped from
4 amending its involved claims to exclude the subject matter of the lost count. See, e.g., In re
5 Johnson, 558 F.2d 1008, 1018, 194 USPQ 187, 196 (CCPA 1977). On the present record, Yu is
6 correct, but in a subsequent proceeding the examiner may produce evidence to show that the
7 amended claims are nevertheless unpatentable over the lost count. We do not, and indeed
8 cannot, prejudge the merits of such a hypothetical rejection.

¹ Tristrata Incorporated of Princeton, New Jersey, also has an interest in the patent.

JUDGMENT

ORDERED that judgment be entered against junior party Yu for the subject matter of count 1, the sole count;

FURTHER ORDERED that Yu claims 2, 5, 13, and 16 be cancelled; and

FURTHER ORDERED that a copy of this decision be entered in the administrative records of the involved patent and application.

cc:

For Yu and Van Scott: [Robert M. Schulman](#), HUNTON & WILLIAMS LLP, of Washington, D.C., with [Patrick A. Doody](#), HUNTON & WILLIAMS LLP, of McLean, Virginia, and [Eugene Rzucidlo](#), HUNTON & WILLIAMS LLP, of New York City, New York.

For Neose Technologies, Inc.: [Todd Esker](#) and [Jeffry Mann](#), MORGAN, LEWIS & BOCKIUS LLP, San Francisco, California.

Notice: Agreements and understandings regarding the termination of an interference are subject to filing requirements under 35 U.S.C. 135(c).

Notice: In the event of judicial review, note the requirements of Bd. R. 8(b).